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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,587	02/12/2004	William H. Eby	1421-154	9316

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JONDLE & ASSOCIATES P.C.
9085 EAST MINERAL CIRCLE
SUITE 200
CENTENNIAL, CO 80112

EXAMINER

KALLIS, RUSSELL

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/779,587

Applicant(s)

EBY, WILLIAM H.

Examiner

Russell Kallis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/12/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/17/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claims 1-29 are pending and examined.

Claims 1, 6, 22, 23 and 28 are objected to for the inclusion of a blank line where the ATCC Accession number should be.

Claim 28 is objected to for grammatical incorrectness. The terms "modified" and "into" should be changed to --modifying-- and --of--.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 6, 20-24, 28 and 29 and claims 2-5, 7-21 and 25-27 dependent thereon, are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6, 22-24, 28 and 29 and claims 2-5, 7-21 and 25-27 dependent thereon, are indefinite in the recitation of "a soybean line designated 0509239", given that a name does not clearly identify the claimed soybean cultivar and seed, and does not set forth the metes and bounds of the claimed invention. Since the name 0509239 is not known in the art, the use of said name does not carry art recognized limitations as to the specific characteristics or essential characteristics which are associated with that denomination. In addition, the name appears to be arbitrary and the specific characteristics associated therewith could be modified, as there is no written description of the soybean plant that encompasses all of its traits. Amending the claims to recite the ATCC deposit number would overcome the rejection.

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Claims 20-21 and 28-29 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.

See MPEP § 2172.01. The omitted steps are: an expression of the transgene step resulting in the modification of fatty acid or carbohydrate metabolism.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-9, 23-24 and 28-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 8-9 are drawn to hybrid soybean seeds, plants produced from said seeds and seeds produced from said plants, wherein one of the parents is 0509239 and the other parent plant is not specified. The hybrid plants are not defined by genomic structure or by phenotypic characteristics, and it is unclear what characteristics of 0509239 would be present in the claimed hybrid seeds and plants. Due to the segregation and recombination of the parent genomes during meiosis, one cannot predict what traits or combinations of traits will be passed on to any given hybrid seed and plant. In fact, *each* hybrid seed derived from a cross between two genetically distinct parent plants will have unique combinations of characteristics. Therefore, the claimed invention lacks an adequate written description.

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Claims 23-24 and 28-29 are drawn to methods of breeding soybeans by outcrossing to a second plant which is uncharacterized except for the presence of a single transgene, followed by at least one generation of backcrossing to the exemplified soybean line, and plants produced therefrom. As discussed above, the plant produced by the initial outcross will have half of its genetic material comprised of the uncharacterized genome of the second parent. After one generation of backcrossing as claimed, at least one quarter of the genome of the resultant plant will be uncharacterized. Accordingly, the traits of said resultant plant will be uncharacterized. Thus, the claimed outcross plant, methods of using it, or single generation backcross plant are all inadequately described.

See *University of California v. Eli Lilly*, 119 F.3d 1567, 43 USPQ 2d 1405 (Fed. Cir. 1997), where it states: “[a] written description of an invention involving a chemical genus, like a description of a chemical species, 'requires a precise definition, such as by structure, formula, [or] chemical name,' of the claimed subject matter sufficient to distinguish it from other materials.”

Therefore, given the lack of written description in the specification with regard to the structural and physical characteristics of the claimed compositions, one skilled in the art would not have been in possession of the genus claimed at the time this application was filed.

Claims 1-29 are rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Since the seed claimed is essential to the claimed invention, it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If

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a seed is not so obtainable or available, the requirements of 35 U.S.C. 112 may be satisfied by a deposit thereof. The specification does not disclose a repeatable process to obtain the exact same seed in each occurrence and it is not apparent if such a seed is readily available to the public. It is noted that applicants intend to deposit seeds for 0509239 at the ATCC, but there is no indication that the seeds have been deposited and there is no indication in the specification as to public availability. If the deposit of these seeds is made under the terms of the Budapest Treaty, then an affidavit or declaration by the applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the seeds will be irrevocably and without restriction or condition released to the public upon the issuance of a patent would satisfy the deposit requirement made herein. A minimum deposit of 2500 seeds is considered sufficient in the ordinary case to assure availability through the period for which a deposit must be maintained.

If the deposit has not been made under the Budapest Treaty, then in order to certify that the deposit, meets the criteria set forth in 37 CFR 1.801-1.809, applicants may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number showing that

(a) during the pendency of the application, access to the invention will be afforded to the Commissioner upon request;

(b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

(c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the enforceable life of the patent, whichever is longer; (d) the

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viability of the biological material at the time of deposit will be tested (see 37 CFR 1.807); and

(e) the deposit will be replaced if it should ever become inviable.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-9 are rejected under 35 U.S.C. § 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over soybean cultivar 739685 (U.S. Patent 6,169,229; issued 1/2/2001).

Applicants have claimed a plant derived from 0509239 soybean after at least one cross and using unspecified second parents, and a method of crossing using said plants, including up to seven generations of crosses and including introduction of herbicide, insect or disease resistance. However, it appears that the claimed plants and seeds are the same as the prior art soybean cultivar 739685, given that each has the same characteristics, including: Roundup resistance, yellow seed coat, dull seed luster, purple flower, light tawny pubescence, brown pod, and yellow cotyledon, for example. Alternatively, if the claimed plants and seeds of 0509239 are not identical to cultivar 739685, then it appears that cultivar 739685 only differs from the claimed

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plants and seeds due to minor morphological variation, wherein said minor morphological variation would be expected to occur in different progeny of the same cultivar, and wherein said minor morphological variation would not confer a patentable distinction to 0509239. Thus the claimed invention was *prima facie* obvious as a whole to one of ordinary skill in the art at the time it was made, if not anticipated by soybean cultivar 739685.

No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (571) 272-0798. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Russell Kallis Ph.D.
April 13, 2005

Russell P. Kallis
**RUSSELL P. KALLIS, PH.D.
PATENT EXAMINER**